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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,737	08/13/2003	Robert M. Grace	1309.09	1736
21839	7590	07/27/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			PASSANITI, SEBASTIANO	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			3711	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/604,737		GRACE, ROBERT M.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Sebastiano Passaniti		3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office action is responsive to communication received 08/13/2003 – application papers; 06/03/2004 – Revocation and new power of attorney.

This application is a CIP of 10/250,070, filed 06/02/2003, which is a CIP of 10/248,342, filed 01/10/2003.

Claims 1-30 are pending.

Following is an action on the MERITS:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/250,070 in view of Chiuminatta, Tunstall. Specific to claim 1-4, the claimed invention of the '070 application differs from the instant claims in that the claimed invention of the '070 application lacks a plurality of trailing weight members, a plurality of first side wall weight members and a plurality of second side wall weight members, whereby the swing weight of the putter may be adjusted by preselecting

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weight members from the plurality of trailing weight members and said first and second side wall weight members. It is rather common especially in the golf club putter art to strategically place weight adjacent the perimeter of a putter head body in order to increase the mass moment of inertia such that off-center shots are less likely to cause club head rotation upon impact of the striking face with a golf ball. Moreover, it is common to provide for a plurality of weighting members at various locations on a putter head in order to customize the swing weight of the putter to suit the individual needs of each golfer. By way of example, note the language in the patent to Tunstall which discusses that the swing weight of a putter head may be adjusted in order to provide proper balance and weight distribution as determined by a golfer (col. 2, line 64 through col. 4, line 38). The patent to Chiuminatta discusses the importance of adjusting the swing weight of a putter in order help correct for a golfer's stroke deficiencies.

Chiuminatta further details that the location of the center of mass of a putter head may be adjusted by varying the swing weight (col.1, lines 53-63 and col. 2, line 67 through col. 3, line 14). In view of the above reasoning and the patents to Tunstall and Chiuminatta, it would have been obvious to modify the claimed device in the '070 application by including a plurality of trailing weight members, a plurality of first side wall weight members and a plurality of second side wall weight members, the motivation being to desirably alter the weight distribution of the head. As to instant claim 2, see claim 2 of the '070 application. As to instant claim 3, see claim 3 of the '070 application. As to instant claim 4, see claim 4 of the '070 application.

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Claims 5-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/250,070 in view of Chiuminatta, Tunstall and Finney. This is a provisional obviousness-type double patenting rejection. The modified claimed invention of the '070 application differs from the instant invention in that the modified claimed invention of the '070 application lacks a recitation of a moment of inertia ranging from as low as about 4390 gm cm<sup>2</sup> to as high as 14,500 gm cm<sup>2</sup> with various swing weights for the putter head body, as required by the instant claims. Finney recognizes that the moment of inertia may in theory exceed 12,000 gm cm<sup>2</sup> and provides a detailed analysis of the reasons for why the inertia value changes depending upon the size of the club head and the materials selected for the club body and the weighting material. See col. 5, lines 14-24 and the section styled "OPERATION OF THE INVENTION", beginning at col. 13 in Finney. It would appear that Finney has indicated a result-effective relationship among the dimensions comprising the club head size along with the weight of the club head and their effect on the value of the moment of inertia. Where a parameter optimized is recognized as being result-effective, that optimization is normally considered an obvious matter to one having ordinary skill in the art. See In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). Under the circumstances here, the instant claimed dimensions for moment of inertia involve no more than the optimization of a result-effective variable and would have been obvious to one having ordinary skill in the art, based on the teachings of Finney. In addition, applicant's recitation in the instant claims

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that the swing weight vary with a change in shaft length is not novel or unobvious. Club sets are often arranged so that the swing weight of a particular club in the set varies with the length of the club shaft.

Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome a provisional obviousness-type double patenting rejection over a pending application (37 CFR 1.321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel\_\_\_\_, Frame\_\_\_\_" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:\_\_\_\_\_ To:\_\_\_\_\_" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.

Applicant's attention is further drawn to the claims of copending application serial number 10/248,342. Applicant is urged to maintain a clear line of demarcation between the instant claims and the claims in the '342 application in order to avoid the need to address concerns over obviousness-type double patenting during prosecution of the instant application.

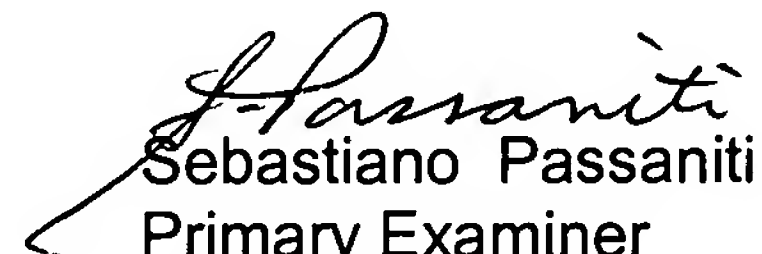
All references cited during prosecution of applicant's parent applications are deemed pertinent to this instant application and are incorporated herein by reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Sebastiano Passaniti  
Primary Examiner  
Art Unit 3711

S.Passaniti/sp  
July 25, 2004

PTO/SB/25 (10-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION</b>	Docket Number (Optional)
<p>In re Application of:</p> <p>Application No.:</p> <p>Filed:</p> <p>For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number _____, filed on _____, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> <div style="display: flex; justify-content: space-between; width: 100%;"> <div style="border-top: 1px solid black; width: 60%;"></div> <div style="border-top: 1px solid black; width: 30%;"></div> </div> <div style="display: flex; justify-content: space-between; width: 100%; margin-top: 5px;"> <span>Signature</span> <span>Date</span> </div> <div style="border-top: 1px solid black; width: 100%; margin-top: 10px;"></div> <div style="text-align: center; margin-top: 5px;">Typed or printed name</div> </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) is included.</p> <p style="text-align: center;"><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> <p style="font-size: small;">*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this statement. See MPEP § 324.</p>	

**Burden Hour Statement:** This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: \_\_\_\_\_

Application No.: \_\_\_\_\_ Filed: \_\_\_\_\_

For: \_\_\_\_\_

\_\_\_\_\_, a \_\_\_\_\_,  
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

2. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

3. From: \_\_\_\_\_ To: \_\_\_\_\_  
The document was recorded in the Patent and Trademark Office at  
Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : \_\_\_\_\_

Name : \_\_\_\_\_

Title : \_\_\_\_\_

Signature: \_\_\_\_\_